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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
STEVENS, THOMAS H	

ART UNIT	PAPER NUMBER
2123	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/715,437	WATSON ET AL.	
	Examiner	Art Unit	
	Thomas H. Stevens	2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-17 were examined.

2. Clams 18-20 are cancelled.

Section I: Final Rejection (5th Office Action)

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The phrase "MacIntosh-compatible systems run the MacIntosh Operating system, MacOs..." was not supported in the original disclosure.

5. Claim 8 contains the trademark/trade name Macintosh. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of

goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a specific computer and, accordingly, the identification/description is indefinite.

New Matter (Specification)

6. The amendment filed 03/30/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "MacIntosh-compatible systems run the MacIntosh Operating system, MacOs and will be referred to as Mac OS compatible".

7. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-17 are rejected under 35 U.S.C. 103 (a) as being unpatentable by Kubinszky "Emulation of Ad-Hoc Networks on IEEE 802-11" in view of Chrysanthakopoulos (US Patent 6,968,307) (hereafter Chrys). Kubinszky teaches a method of emulating an entire network that encompasses IEEE standard 802.11; but fails to teach a plurality of emulation events from various personal computers. Chrys teaches a method of emulating difference devices from various personal computers (column 5, lines 29-30 and column 6, lines 21-25). Kubinszky and Chrys are analogous art since they both teach emulation of hardware devices.

Therefore, at the time of invention, it would have been obvious to one having ordinary skill in the art at the time of invention to utilize pc emulation network of Chrys in the emulation test bed of Kubinszky since Chrys teaches a method that's advantageous to allow devices to transmit such files over a serial bus without conversion (column 2, lines 55-59).

Claim 1. An operating environment emulation system (Kubinszky: title and Chrys: column 1, lines 40-42), comprising: a memory to: store multiple emulators (column 5, lines 29-30), wherein each emulator contains instructions to emulate a particular operating environment having a particular operating system (Chrys: column 9, lines 9-10); and store a data file containing elements necessary to execute an emulated operating system operating on a first computer (Chrys: column 2, lines 49-50); and a connector, operable to allow the memory to be disconnected from the first computer and to connect the memory to a host computer (Kubinszky: pg.11, section 3.2.1., 1st paragraph, lines 6-8).

Claim 2. The system of claim 1, wherein the connector is a Universal Serial Bus cable accordance with 802.11b (encompass entire IEEE standard; Kubinszky: title).

Claim 3. The system of claim 1, wherein the connector is an IEEE-1394 cable (Chrys: column 4, lines 30-35 and Kubinszky: pgs 26-27, Section 5.2.2. 1st paragraph).

Claim 4. The system of claim 1, wherein the connector uses an infrared link (Kubinszky: pg. 4, section 2.1.1.)

Claim 5. The system of claim 1, wherein the connector is an Ethernet cable (Chrys: column 4, lines 61-64 and Kubinszky: pgs 26-27, Section 5.2.2. 1st paragraph).

Claim 6. The system of claim 1, wherein the connector uses a wireless link in accordance to 802.11b (encompass entire IEEE standard; Kubinszky: pg.34, table 5.3 "Link Type").

Claim 7. The system of claim 1, wherein the host computer is personal computer compatible (Chrys: column 2, lines 64-66).

Claims 8. The system of claim 1, wherein the host computer operates under Mac OS (encompasses all personal computers: Chrys: column 2, lines 64-66).

Claim 9. The system of claim 1, wherein the multiple emulators (Chrys: column 5, lines 29-30) further comprise emulators for different operating systems (inherent to the multiple pc since not all pc run on the same operating system).

Claim 10. The system of claim 1, wherein the multiple emulators (Chrys: column 5, lines 29-30) further comprise emulators for different processors (inherent to the multiple pc since not all pc run on the same processors).

Claim 11. The method of establishing an emulated operating environment on a host computer (Kubinszky: title and Chrys: column 1, lines 40-42), the method comprising: transferring a data file (Chrys: column 2, lines 55-60) containing necessary elements to emulate an operating system from a first computer having an operating system (Chrys: column 2, lines 63-65) to be emulated to a memory device (Chrys: column 3, lines 41-50) upon which reside multiple emulators; disconnecting the memory device from the first computer (inherent: user simply unplugs the first computer; Chrys: columns 5-6, lines 65-67 and 1-8, respectively); connecting the memory device to a host computer having an original operating system (users' ability of connection to a plurality of devices; Chrys: column 5, lines 25-35 and lines 56-60); using the original operating system to load an emulator from the memory device to the host computer based upon the operating system to be emulated (users' ability of connection to a plurality of devices; Chrys: column 5, lines 25-35 and lines 56-60); and executing the emulator to access the data file to establish an emulated operating environment on the host computer to operate on the data file (Chrys: column 6, lines 56-60).

Claim 12. The method of claim 11, wherein method further comprises receiving a user input designing the emulator to be loaded from the memory device (Chrys: column 6, lines 30-41).

Claim 13. The method of claim 11, wherein the method further comprises selecting an emulator automatically, (Chrys: column 3, lines 15-17) wherein the selection is made by the host computer.

Claim 14. The method of claim 11, wherein connecting the emulation system to the host computer further comprises connecting the emulation system to an accessory device (Chrys: column 5, lines 12-21).

Claim 15. The method of insulating an operating environment emulator from a host computer, the method comprising: connecting an emulation device to a host computer (Kubinszky: title and Chrys: column 1, lines 40-42); executing an emulated operating system located on the emulation device on a processor of host computer having an original operating system (Chrys: column 3, lines 9-18); disabling host task management on the original operating system (Chrys: column 7, lines 40-46); routing input/output signals only through the emulated operating system (access to various network mediums; Chrys: 4, columns 31-37); and activating an environmental shutdown (inherent: cut the power) by disabling the emulated operating system if necessary to

prevent interactions between the original operating system and the emulated operating system.

Claim 16. The method of claim 15, wherein disabling further comprises completely isolating the host computer (Chrys: column 7,line 45-46).

Claim 17. The method of claim 15, wherein disabling further comprises allowing a user to define allowed interactions between the host computer and the emulation device (Chrys: column 7,line 45-46).

Response to Applicants' Arguments (4th Office Action)

Prior Art

11. The Office apologies for the mishap. An abstract of the publication date by Kubinszky has been provided within this office action.

Trademark

12. Applicants are thanked for addressing this issue. The issue is still outstanding since the applicants' amendment initiated a new matter issue which cannot be entered, thus maintaining the rejection under 35 U.S.C. 112 2nd.

112 2nd

13. Applicants are thanked for responding to this issue. Rejection is withdrawn.

103(a)

14. Applicants argue that the Kubinszky reference is not directed to an environment where the operating system makes any difference. In fact in Kubinszky's abstract (2nd paragraph) denotes "emulation capabilities...include how to actually connect real machines and their implemented protocols to the emulation" encompassing all machines since all machines have different processors with many different capabilities.

Applicant argues that the Chrys reference does not interact with the operating system. It appears the applicants are reading the specification into the claims (applicants' arguments, pg. 7, 4th paragraph). The Office agrees with applicants that not all pc's run on the same operating system (applicants' response pg.7, paragraph 3); however, the Chrys reference states "The PC can emulated multiple devices at the same time" (column 3, lines 9-10) which can operate on "networked environment" (column 4, lines 38-39) on a "general purpose operating system" (column 9, lines 10-11); coupled with Kubinszky's teaching of different ad-hoc devices for emulation, each having a different electronic processor (Kubinszky: abstract, lines 1-3 and 7). It's not impermissible extension (applicants' response pg. 7, 5th paragraph) if the limitation is a species of a genus to which the prior art depicts; in this instance, the applicants are claiming a specific operating system to which the prior art states different computers have different components and devices which would include different operating systems (Chrys: column 1, lines 13-20). Furthermore, since this is a 103-based rejection it would be obvious to one of ordinary skill in the art that PC linked together don't necessarily have the same operating system.

In response to applicant's arguments (pg. 8, 4th paragraph) against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Rejection stands.

Citation to Relevant Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent 6,862,564 teaches a system and method for providing an emulated network including a plurality of computer processors.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Tom Stevens whose telephone number is 571-272-3715, Monday-Friday (8:00 am- 4:30 pm EST).

If attempts to reach the examiner by telephone are unsuccessful, please contact examiner's supervisor Mr. Paul Rodriguez 571-272-3753. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov.. Answers to questions regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) (toll-free (866-217-9197)).

Paul L. Rodriguez 6/9/06
Primary Examiner
Art Unit 2123

June 4, 2006

TS